

REMARKS

Claims 1-19 are currently pending. In the Office Action mailed March 25, 2005, the Examiner rejected claims 1-13, 15, and 17-19, and objected to claims 14 and 16. New claim 20 has been added.

Claims 7, 8, 10, 11, and 15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The examiner stated that the claims 7, 8, and 10 had insufficient antecedent basis. Claim 1 has been amended to include a locking means thereby correcting the problem with antecedent basis in claims 7, 8, and 10. The examiner rejected claims 11 and 15, but gave no specific reason for the objection. Claim 11 is cancelled. It is our contention that there are no § 112, second paragraph problems of indefiniteness with the current claim 15 and therefore the claims are allowable.

Claims 1-9, 12-14, 17, and 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Dawson (U.S. Pat. No. 1,769,120). Claim 1, in its current amended form, is not anticipated by Dawson. The examiner stated that Dawson disclosed an accessory for a file comprising: a U-shaped holder having a supporting plate, which can be provided to a file in a clamping manner, wherein the holder works in conjunction with a binding mechanism and can be manually attached for fixing the holder to the file, wherein the binding mechanism includes rigid rings, wherein the rings include two parts provided on a base element and movable between an open and close position; wherein the binding mechanism is mounted on the holder in a replaceable manner; and a detachable connecting means having a snap-in connection; wherein a locking means can mesh in an opening of the file.

The structure in Dawson as indicated by the examiner as (25, 25, 26, 27, and 28) is not the recited holder in the current invention. As stated in the amended claim, the U-shaped holder for the current invention has at least one elastically bendable leg. The structure indicated by the examiner in Dawson contains no elastically bendable features. Also the U-shaped holder for the current invention is designed to engage the writing board, file or the like at two contact surfaces

on the two legs of the U-shaped holder that are turned toward one another. The structure indicated by the examiner in Dawson does not engage the file in this manner. The structure in Dawson does not have two contact surfaces facing one another, which contact the file. The structure in Dawson contacts only one of the sides of the file. For these reasons, the current claim 1 is not anticipated by Dawson and is allowable.

Claims 2 and 12-14 are cancelled. Claims 3-9, 17, and 18 depend from claim 1 which is not anticipated by Dawson. These claims include all of the limitations of claim 1 and, in addition to those limitations, recite unique combinations of elements that are not taught in the art. Therefore claims 3-9, 17, and 18 are not anticipated by Dawson and are allowable.

Claims 1, 10, 11, and 15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Emery (U.S. Pat. No. 2,093,041). Claim 1, in its current amended form, is not anticipated by Emery. The examiner stated that Emery disclosed an accessory for a writing board comprising: a U-shaped holder having a supporting plate, which can be provided to a file in a clamping manner, wherein the holder works in conjunction with a binding mechanism and can be manually attached, through a stud and nut, to the writing board; wherein a means for fixing are configured such that the holder can be fixed over an edge of a rigid wall part of the writing board; wherein the holder comprises an elastically bendable parts.

The adapter in Emery as indicated by the examiner (shown in Fig 3.) is not the U-shaped holder in the current invention. While the adapter in Emery does contain an elastically bendable portion, the configuration of this portion is such that the adapter is in an open position and the portion elastically bends closed when the holder is coupled to the writing board. The U-shaped holder in the current invention is in a closed position. The leg elastically bends open to put the U-shaped holder in an open position to attach to the writing board, and then the holder returns to its original closed configuration to lock the holder to the writing board. The adapter in Emery does not have a locking means that meshes in an opening when the leg of a U-shaped body is bent open. In Emery, the adapter is held to the writing board, as indicated by the examiner, by a stud and a nut. The stud and nut are attached to the binding mechanism and it is the stud on the

binding mechanism, protruding through the adapter that pulls the elastically bendable portion towards the writing board and fixes the adapter in place. In the current invention, the binding mechanism does not assist in attaching the U-shaped holder to a writing board. The current invention utilizes locking means, such as round pins, attached to the elastically bendable leg that mesh with the openings in the writing board, file or the like. The U-shaped holder can attach to the writing board, file, or the like with or without the binding mechanism being attached to the U-shaped holder. This is not possible with the adapter in Emery. For these reasons, the current claim 1 is not anticipated by Emery and is allowable.

Claim 11 is cancelled. Claims 10 and 15 depend from claim 1 which is not anticipated by Emery. These claims include all of the limitations of claim 1 and, in addition to those limitations, recite unique combinations of elements that are not taught in the art. Therefore claims 10 and 15 are not anticipated by Emery and are allowable.

Claims 1, 17, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Moor et al. (U.S. Pat. No. 6,431,779) in view of Emery. The examiner stated that the combination of Moor which discloses an accessory for a file, wherein the file consists of a front wall part, a rear wall part connected thereto by means of a back part, and at least on inwardly folded flap, whereby a holder is mounted to an edge of the flap. The examiner further stated that this reference when viewed in conjunction with Emery, which discloses an adaptor working in conjunction with a binding mechanism that can be mounted to a free edge of a file, would have been obvious to one having ordinary skill in the art at the time to modify Moor's accessory with a manually detachable edge clamping holder which is connected to a binder mechanism.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally the prior art reference (or references when combined) must teach or suggest all the claims limitations (see MPEP § 2143). Claim 1 in the current invention calls for an accessory for a

writing board, a file or the like, comprising a holder which can be provided to a file or the like wherein said holder is made of a predominantly U-shaped body with legs that define contact surfaces on their sides turned toward one another. The holder is configured for working in conjunction with a binding mechanism of the type comprising elements over which documents that are provided with openings can be threaded, wherein at least one of the legs is elastically bendable and includes locking means in the form of a part that is configured to mesh in an opening in the file or the like, so the holder can be configured to manually attach to a file or the like.

The prior art references, when combined, do not teach all of the claim limitations. As discussed above, claim 1 is not anticipated by Emery. There are significant differences in the method of attachment between the adapter in Emery and the U-shaped body in the current invention. In the current invention, the binding mechanism does not assist in attaching the U-shaped holder to a writing board, a file or the like. The current invention utilizes a locking means, such as round pins, attached to the elastically bendable leg that mesh with the openings in the writing board, file or the like. The U-shaped holder can attach to the writing board, file or the like with or without the binding mechanism being attached to the U-shaped holder, which is not possible with the adapter in Emery. The configuration of the adapter in Emery initially being in an open position and elastically bendable to a closed position is different from the U-shaped body in the current invention which is initially in a closed position and is elastically bendable to open the U-shape body to be able to attach to the writing board, file or the like. The U-shaped body then returns to its original closed position, fixing the U-shaped holder to the writing boards, file or the like. The adapter in Emery does not have a locking means that meshes in an opening when the leg of a U-shaped body is bent open. For these reasons, the criteria for obviousness have not been met and claim 1 is patentable over Moor et al. in view of Emery and is allowable.

Claims 17 and 19 depend from claim 1 which is patentable over Moore et al. in view of Emery. These claims include all of the limitations of claim 1 and, in addition to those limitations, recite unique combinations of elements that are not taught in the art. Therefore, claims 17 and 19 are patentable over Moor et al. in view of Emery and are allowable.

Application Serial No. 10/620,780
Amendment dated November 6, 2003
Reply to Office Action of March 25, 2005

It is acknowledged that claims 14 and 16 were objected to as depending from a rejected base claim, but were indicated to be allowable if rewritten into independent form including all of the limitations of the base claim and any intervening claims. Claim 14 is cancelled. The claims on which claims 15 and 16 depended have been amended to overcome the § 102(b) anticipation problem, therefore those claims are no longer without a base claim and are allowable in their current form.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is found that the present amendment does not place the application in a condition for allowance, applicant's undersigned attorney requests that the examiner initiate a telephone interview to expedite prosecution of the application.

Applicant encloses a check in the amount of \$60.00 for a one-month extension of time to file a Response to the Office Action herein. Applicant knows of no additional fees due herein with this submission. However, if any charges or credits are necessary, please apply them to Deposit Account 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.



Kurt A. Summe
Reg. No. 36,023

2700 Carew Tower
441 Vine Street
Cincinnati, Ohio 45202
(513) 241-2324
(513) 421-7269 facsimile